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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM Y. SUN

Appeal 2007-0692
Application 10/729,973
Technology Center 3700

Decided: July 8, 2008

Before WILLIAM F. PATE, III, DEMETRA J. MILLS, LORA M. GREEN,
LINDA E. HORNER, and RICHARD M. LEBOVITZ, *Administrative
Patent Judges*.

LEBOVITZ, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Technology Center 3700 requests rehearing under 37 C.F.R. § 41.52 of the Board Decision entered March 8, 2007 (“Decision”) in which the Examiner’s final rejection of independent claim 1 and dependent claim 8 over prior art was reversed.

ISSUE

Claim 1 is drawn to a “tongue stabilizer for a laryngoscope blade” that comprises three elements: 1) a “tongue-engaging plate;” 2) a “foam strip support” attached to the plate; and 3) a “pressure-sensitive adhesive” attached to the foam support. In our Decision entered March 8, 2007, we reversed the Examiner’s rejection of claim 1 (and dependent claim 8) as anticipated under 35 U.S.C. § 102(b) by Panduit (Product Bulletin, “ABM112 Adhesive Backed Cable Tie Mount,” pp. 28-29, 1999).

Technology Center 3700 (“Tech Center”) requests rehearing and reconsideration¹ of this decision to reverse the anticipation rejection. The Tech Center contends that the Board erred in reversing the rejection by improperly “reading a limitation” from the Specification into the “tongue-engaging plate” of claim 1 (Req. Reh’g 4).

DISCUSSION

Claim interpretation is at the heart of patent examination, because until a claim is properly interpreted it cannot be compared to the prior art. This case involves the interpretation of the term “tongue-engaging plate.” In our Decision, we interpreted “tongue-engaging plate” to mean “a structure which, when attached to a laryngoscope blade and in contact with the tongue, must be capable of confining and holding the tongue on its surface” (Decision 4). The Tech Center contends that our interpretation is improper because we imported structural limitations into it from the Specification.

¹ The Request for Rehearing was filed by the Tech Center on March 20, 2008, a little over one year from the date of the Decision. It is regrettable that over a year elapsed until the Tech Center filed the Request for Rehearing.

The “tongue-engaging plate” is a structural element of the claimed “tongue stabilizer.” The claim, however, does not explicitly recite the structural features which enable it to perform the “tongue-engaging” function. Claims terms, however, are given their broadest reasonable meaning in “light” of the specification. *In re Crish*, 393 F.3d 1253, 1257 (Fed. Cir. 2004). Thus, we are to refer to the Specification to take into account how the term has been used by the inventors and whether it has been given any special meaning. In this case, the term “tongue-engaging plate” is not explicitly defined in the Specification. However, as we explained in our Decision, the Specification teaches that

[w]hen in contact with the tongue, the plate is used “to confine the tongue and prevent it from slipping and obstructing and/or obscuring the throat passage.” (Specification 5: 3-5.) This contact is necessary to “support” (*Id.* at 4:16) and “confine” the tongue during an intubation procedure (*Id.* at 5: 3-5; 6: 4-7).

In addition to confining the tongue, the tongue-engaging plate also “holds” the tongue. As pointed out in the “Description of Related Art,” prior art laryngoscopes “are narrow and can hold only approximately half of the tongue, so that it is very hard to make the tongue stay on the laryngoscope blade with any degree of stability.” (*Id.* at 1: 13-15.) To solve this problem, Appellant provides a tongue-engaging plate which, when attached to the laryngoscope, holds the tongue on its surface so it does not slip off and obscure the throat passage (*Id.* at 5). Preferred shapes are that of a spoon or a concave upper surface “to cradle the tongue.” (*Id.* at 4: 16-17.)

(Decision 4).

To sum up, we understood from the Specification that the “tongue-engaging plate” is the structure in a laryngoscope blade that, when used during an intubation procedure, confines and holds the tongue. Thus, the claimed tongue-engaging plate has a purpose or intended use. In the context

of language in a claim preamble, it has been stated that the “determination of whether preamble recitations are structural limitations or mere statements of purpose or use ‘*can be resolved only on review of the entirety of the patent* to gain an understanding of what the inventors actually invented and intended to encompass by the claim.’” *Rowe v. Dror*, 112 F.3d 473, 478 (Fed. Cir. 1997) (internal citations omitted) (emphasis added). This same analysis applies to intended use statements in the body of the claim. *See In re Stencel*, 828 F.2d 751, 754 (Fed. Cir. 1987) (statements of intended use often appear in the claim’s preamble, although not necessarily). Thus, under the relevant legal principles, we are directed to the Specification to properly interpret the meaning of “tongue-engaging plate.”

As discussed above, review of the Specification reveals that the “tongue-engaging plate” is a structural limitation that requires it to confine and hold the tongue. Panduit has no such structure in it. Rather, Panduit shows a cable mount that has two top surfaces attached to the self-adhesive form tape: an upper raised platform surface which lies on a wider bottom surface base, where the two surfaces are connected by downwardly sloping lines on each corner (Panduit, at p. 28; *See* Reply Br. 9; Decision 5.) The raised platform is a bridge that forms an opening through which wires are inserted (Panduit, at p. 28-29). In reversing the rejection, we agreed with Appellant that Panduit does not describe a “tongue-engaging plate” because the cable mount surfaces do not have a structure which would enable them to confine and hold the tongue during an intubation procedure (Decision 6).

The Tech Center argues that

the Board went too far by requiring “a structure which, when attached to a laryngoscope blade and in contact with the tongue, must be capable of confining and holding the tongue on its

surface” (bottom of page 4 of the decision). This function and the structure for this function are not expressly recited in the claim. We believe that the Board improperly relied on a portion of the specification that describes the preferred embodiment because the Board supported its determination by stating (on page 6 of the decision) that “the specification describes this structure generally as an “elongated” plate having preferred **spoon or concave shapes (Specification 4: 14-17) to hold the tongue in place**” (with emphasis added).

(Req. Reh’g 5).

This argument is not persuasive. The Tech Center argues that we “went too far” in our interpretation of “tongue-engaging plate,” but the only specific defect they allege is that we improperly relied upon a preferred embodiment described in the Specification in supporting our definition. This is not correct. The Decision explicitly acknowledges that a ““spoon or concave”” surface is a “preferred” shape described in the Specification to ““cradle”” the tongue; we did not limit the plate to these shapes, instead defining the plate more broadly as “elongated” in accordance with its description in the Specification (Decision 6). Claim terms are necessarily read in the context of the Specification to shed light on their meaning. *See Rowe v. Dror*, 112 F.3d at 479.

Our interpretation of “tongue-engaging plate” does not refer to the term “cradle” (as used in the Specification, at 4: 16-17, to characterize the spoon and concave shapes) nor does it use any language that would indicate we improperly narrowed its meaning to a preferred embodiment described in the Specification.

The real question in this case – that the Tech Center does not address – is whether Panduit’s cable mount could be used as a tongue stabilizer for a laryngoscope blade as required by claim 1. Appellant has

provided a rebuttal explanation as to why the Panduit structure would be incapable of holding a tongue: because it is an “irregular” top surface “shaped to hold cable wires in a permanent position between upstanding protrusions” (App. Br. 19). However, the Tech Center did not explain in response how an irregular surface could perform the function required by the “tongue-engaging plate” of claim 1.

The Tech Center contends that the “Board’s interpretation of ‘tongue-engaging plate’ would render claim 3 improper under 35 U.S.C. § 112, 4th paragraph, because claim 3 would have the same limitations as claim 1” (Req. Reh’g 6). Claim 3,² which is dependent on claim 1, recites that “said tongue engaging plate top central area is recessed to provide a tongue-cradling concavity” (Amendment dated Aug. 8, 2005, at 12). We agree with the Tech Center that claim 3 is apparently directed to the preferred concave shape. However, we have not interpreted the plate of claim 1 to be concave, but rather interpreted it more broadly to have an “elongated” shape which is capable of holding and confining the tongue (Spec. 4: 14-15; Decision 4). The Specification explicitly states that “a flat plate can function adequately to confine the tongue” (Spec. 5: 3-4), consistent with our broader interpretation of tongue-engaging plate to refer to a structure which can “confine” the tongue.

Citing *In re Schreiber*, 128 F.3d 1473, 1477-78 (Fed. Cir. 1997), the Tech Center states that “claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function” (Req. Reh’g 6). In *Schreiber*, claims to a “dispensing top” having an

² Claim 3 apparently contains allowable subject matter; it is objected to, but not rejected (App. Br. 4).

opening to allow “several kernels of popped popcorn to pass through at the same time” was rejected over prior art having a spout for dispensing oil. *In re Schreiber*, 128 F.3d at 1475-76. Schreiber argued that the prior art did not disclose a structure to dispense popcorn. *Id.* at 1477. However, the court held that the “intended use” of the claimed dispensing top did not distinguish it over the cited prior art because it was deemed to have a structure completely described in the prior art reference, but for a different purpose. *Id.* at 1477. Here, we have concluded that the prior art cable mount surfaces would not be capable of performing the claimed function; thus, the structure of the claimed “tongue-engaging plate” is not described in the prior art.

CONCLUSION

We have considered the Tech Center’s Request for Rehearing, but decline to modify our original Decision entered March 8, 2007.

REHEARING DENIED

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